

REMARKS

The Applicant presents these remarks with reference to and incorporating by reference the remarks presented in the previous response to the outstanding Office Action filed March 19, 2008.

The present Request for Reconsideration is provided to fully address the issues identified by the Examiner in the Office Action of July 1, 2008. It is believed that this Request for Reconsideration is fully responsive in light of the outstanding Office Action and accordingly is a bona fide attempt to advance the prosecution of the application.

Summary

The Examiner has alleged that the O'Malley reference is the primary prior art "since it clearly teaches the earpiece of a telephone headset is mounted on pivot members to pivot about an axis generally in the plane of the headband being capable of pivoting for about 120 degrees to enable pivoting of the earpiece such that it can be held against an ear without the headband being on the users head" and that "O'Malley teaches a headset that may be configured for the head worn or hand held configurations." Outstanding Office Action, p 4 (page 2 of detailed action). However, O'Malley, and the other references of record, does not teach the recited elements and function of when "in a head-worn configuration on the head of a user", or rotatable in "both a left and right rotation in a head-worn configuration on the head of a user . . . to a hand-held configuration." Claim 1; see claims 35, 37, and 63. The O'Malley technology utilizes features such as stirrups that prevent the headset from rotating in both directions when on the head of a user to a hand held configuration, the stirrups contacting the head of the user or portions of the headset that prevent rotation in both a left and right rotation in a head-worn configuration on the head of a user to a hand-held configuration. The other art of record does not teaching the missing limitations, does provide any suggestion or motivation, and is not relied upon by the examiner for these claimed limitations. Accordingly, the art of record does not teach nor suggest the invention as presently claimed.

Previous Amendments to the Claims

The previous amendment to the claims presented some inventive, novel and nonobvious aspects of the present invention. The claims have supportive argument for novelty and nonobviousness as described in the previous Amendment and Request for Reconsideration. However, in the interest of providing a full understanding of the technology of the present invention embodied as a wireless communication headset system and wireless communication headset, as well as methods of configuring such, further remarks and argument are herein provided to highlight inventive features recited in the present claims in light of the cited art and art considered pertinent by the Examiner.

As a brief summary of some operation and features in accordance with embodiments of the present invention, in light of the outstanding rejection of claims, and as but one example, the wireless communication headset system may be operated as follows. A user may receive an incoming call or other communication or information through the technology. As an example, the user receives a telephone call. The user may then engage the system or headset to answer the call and understand the identity of the caller and the likely purpose and substance of the telephone conversation. The user may then decide to remain in the telephone conversation and keep the system in its original configuration when the call was answered. The system may be in a head-worn configuration or in a hand-held configuration.

However, the user may then decide to change the configuration of the system, in part based upon the expected telephone conversation and based upon other factors such as user preference and comfort. In one example, the user may elect to use the system in a hand held configuration and may rotate the headband, left and right, about a rotatable connection of the telephone control at a distal end of the headband when in a head-worn configuration on the head of a user. An important aspect of the present invention is that the features and process may occur or function “in a head-worn configuration on the head of a user.” Claim 1, for example. Another important aspect is that the invention is rotatable in “both a left and right rotation in a head-worn configuration on the head of a user . . . to a hand-held

configuration.” Claim 1, for example.

The user is not confined to one particular rotation direction, having the ability to rotate the headband in a left or right rotation and still providing for a hand-held configuration while in a head-worn configuration on the head of a user. Not only will the invention provide for unobstructed rotation of the headband while on the head of the user, but will also allow the rotation of the headband, left or right on the head of the user, without the limitations of having portions of the headset interfere with hand-held use. As but one example, the headset of U.S. Patent No. 4,634,816 will only rotate in one direction when on the head of the user, the stirrups 14 interfering with the head of the user and the speaker and other portions of that traditional headset. It cannot rotate in both directions when in a head-worn configuration on the head of a user to a hand-held configuration. It cannot rotate in 180 degrees of direction. It cannot rotate in either a left or right rotation, or in both a left or right rotation, to achieve head-worn and hand-held configurations, to achieve 180 degrees of rotation or when on the head of a user. The technology of the ‘816 patent cannot rotate in one direction in a head-worn configuration on the head of a user without the stirrup interfering with use of the headset on the head of the user, such that the stirrup will either or in combination hit or contact the head of the user, be interposed between or obstruct the ear of the user relative to the ear piece, or will not rotate given interference between the stirrup and other portions of the earpiece and/or the microphone to a hand-held configuration. These functional and feature incompatibilities and lack of solutions to the problem in the ‘816 patent and other cited references make the present invention novel and nonobvious as claimed at least for these reasons. More distinctions are highlighted below.

Furthermore, when configured in a hand-held configuration, the technology of the ‘816 patent cannot rotate in one direction with the stirrup interfering with use of the headset, such that the stirrup will either or both be interposed between or obstruct the ear of the user relative to the ear piece or will not rotate given interference between the stirrup and other portions of the earpiece and/or the microphone.

Prior Art Issues

The Examiner has alleged that certain claims are made obvious in light of the cited references or notice taken by the examiner, all being allegedly unpatentable over O'Malley et al. (U.S. 4,634,816) in view of Hall et al and other cited patents. It is presently asserted that the claims are novel and nonobviousness in light of the art of record, both as cited and as noted by the Examiner as pertinent, as argued above and herein, and accordingly the outstanding rejections based upon such references should be withdrawn.

O'Malley et al. does not teach or suggest the features of the independent claims

The Examiner is respectfully referred to Figures 1, 3, 8 and 11. In these figures, it is clear that the O'Malley technology can only rotate in one direction to allow for an earpiece to be held against the ear. The stirrups 13, 14 comprise an arcuate member 40 that might allow rotation in one direction, such as may be shown in Figure 11, but would not allow rotation in the opposite direction in the circumstance that:

- 1) The headset is on the head of the user, and, for example, if the headset were rotated opposite of the rotation shown in Figure 11, the stirrup 13, 14 and arc member 40 would contact the head of the user or components of the headset such as the housing 30 or receiver cap 34. It is further important to note that the rotation appears to be impossible as disclosed in Figure 1, wherein attachment member 15 and hollow arm 70 would interfere with rotation and contact the stirrup 13, 14 and arc member 40.
- 2) The headset is simply rotated in both a left or right rotation, wherein one of the two rotation directions would not allow the headset to rotate into a hand-held configuration, as again the stirrup 13, 14 and arc member 40 would contact the components of the headset such as the housing 30 or receiver cap 34 in one directional rotation, and wherein attachment member 15 and hollow arm 70 would interfere with rotation. Furthermore, in one direction of rotation, such as a direction opposite to that shown in Figure 11, the stirrup 13, 14 and arc member 40 would actually be interposed between the earpiece and the ear of the user, interfering with its use.

- 3) The Examiner correctly identifies on page 12 of the Outstanding Office Action (page 10 of the detailed action) that O'Malley only teaches about 120 degrees of rotation. No further modification is taught or suggested by O'Malley or the other art of record to allow 180 degrees of rotation as it would be impermissible hind sight and would alter the basic concept and function of the O'Malley et al. technology and its stirrups and arc members to do so.

The headset of the O'Malley et al. reference lacks features claimed in the present invention, and particularly those of independent claims 1, 35, 37 and 63. The independent claims recite claim features that are not found in the O'Malley et al. reference and that are counter to the mechanics and objectives of the O'Malley et al. technologies and other art of record.

The present invention is not obvious in light of the prior art of record

The Examiner has not shown or established that at the time the invention was made, all claim limitations are taught or suggested by the cited art, established the suggestion or motivation to modify or combine the cited references, even if the claim limitations were taught, or a reasonable expectation of success, with respect to the claimed recitations of claims 1, 35, 37, and 63.

The Examiner bears the burden of establishing a prima facie case to support an obviousness rejection. MPEP 2142. Furthermore, it would appear that the Examiner uses a basis of rationale for obviousness in light of the recognized standard that some teaching in the prior art would have led one of ordinary skill in the art to combine the prior art teachings to arrive at the claimed invention. See MPEP 2143; KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1395-97 (2007).

All claim limitations are not taught or suggested by the cited art

Preliminary, the Examiner must first resolve the Graham factual inquiries. MPEP 2143(G). One such mandatory inquiry is that "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In the present claims, the elements of the claim require "in a head-worn configuration on the

head of a user.” Claim 1, for example. Another claim recitation is that the invention is rotatable in “both a left and right rotation in a head-worn configuration on the head of a user . . . to a hand-held configuration.” Claim 1, for example. Neither of these features is found in the cited prior art of the O’Malley et al. reference and are not found, taught or suggested in the other cited prior art. In the context of the recited claim elements, the Examiner has not shown these elements to be taught, suggested, or motivated.

The disclosure of U.S. patent 4,634,816 lacks teaching, suggestion and motivation to modify, particularly in light of the lack of a reasonable expectation of success, given that the headset of U.S. Patent No. 4,634,816 will only rotate in one direction when on the head of the user, the stirrups 14 hitting, contacting or interfering with the head of the user and the speaker and other portions of that traditional headset. It cannot rotate in both directions when in a head-worn configuration on the head of a user to a hand-held configuration. The technology of the ‘816 patent cannot rotate in one direction in a head-worn configuration on the head of a user without the stirrup interfering with use of the headset on the head of the user, such that the stirrup will either or in combination hit or contact the head or the user, be interposed between or obstruct the ear of the user relative to the ear piece, or will not rotate given interference between the stirrup and other portions of the earpiece and/or the microphone to a hand-held configuration. These functional and feature incompatibilities and lack of solutions to the problem in the ‘816 patent and other cited references make the present invention novel and nonobvious as claimed at least for these reasons.

Furthermore, as previously described, it is problematic that even when configured in a hand-held configuration, the technology of the ‘816 patent cannot rotate in one direction with the stirrup interfering with use of the headset, such the stirrup will either or both be interposed between or obstruct the ear of the user relative to the ear piece or will not rotate given interference between the stirrup and other portions of the earpiece and/or the microphone.

Again, the Examiner is respectfully directed to the claim language of independent claim 1, for example, reciting “in a head-worn configuration on the head of a user”, and rotatable in “both a left and right rotation in a head-worn configuration on the head of a user . . . to a hand-held configuration.”

Claim 1, for example. The O'Malley reference cannot perform and does not teach, suggest or motivate to rotate in both a left and right rotation in a head-worn configuration on the head of a user, much less to do so in a head-worn configuration on the head of a user to a hand-held configuration.

The user of the present invention is not confined to one particular rotation direction, having the ability to rotate the headband in a left or right rotation in a head-worn configuration on the head of the user, and still providing for a hand-held configuration. Not only will the invention provide for unobstructed rotation of the headband while on the head of the user, but will also allow generally the rotation of the headband, left or right and on or off the head of the user, without the limitations of having portions of the headset interfere with hand-held use.

Again, the headset of U.S. Patent No. 4,634,816 will only rotate in one direction when on the head of the user, and when in a head-worn configuration, the stirrups 14 interfering with the head of the user and the speaker and other portions of that traditional headset.

The recitation of the claims have accordingly not been taught, suggested or motivated by the art of record. While recitations of claim 1 have been discussed, features of the other independent claims have not been taught, suggested or motivated by the art of record consistent with the above argument.

These exemplary recitations, without limiting the possibility of other claimed limitations not also being present, are found in the independent claims, for example:

- Claim 35: 1) c. ...are rotatable in 180 degrees of rotation about said vertical axis to a head-worn configuration and a hand-held configuration
and
2) ...wherein said headband and said telephone control are each rotatable about said vertical axis to a head-worn configuration of said headband and said telephone control and to a hand-held configuration of said headband and said telephone control in both a left or right rotation.

Furthermore, in light of the argument above in reference to independent claim 35, the Examiner

admits in the outstanding office action, page 10, that the rotation limitation has not been taught. Accordingly, the assumption of modification is dealt with below. Independent claims 37 and 63 as method claims have recited claim limitations similar to those discussed with respect to claims 1 and 35, and are therefore not taught, suggested or motivated by the prior art in accordance with the arguments presented above and herein.

As previously described and as explained by the Examiner in the outstanding Office Action, the Mack et al. reference does not teach, suggest or motivate claimed features of the present invention, and particularly those argued above and herein. Furthermore, as also previously described, the Hall et al. reference does not teach the missing claim limitations, does not provide motivation to modify or combine the cited references in any event, and provides no reasonable expectation of success even if such references were modified or combined. It is further urged that the other patent references cited by the Examiner also do not afford the missing parameters of O'Malley, Mack et al., and Hall et al. necessary to support a rejection based upon obviousness.

No Motivation to Combine What is Not Taught

The rationale to support a conclusion that the claim would have been obvious is that “a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success.” MPEP 2143(G), citing *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006). If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. MPEP 2143.

As described above, the O'Malley et al. patent does not even teach the recited claim limitations and the other art cited and of record does make up for the lack of teaching. This is true particularly for the claim limitations such as those the Examiner is respectfully directed to in the claim elements and limitations of independent claim 1, for example, reciting “in a head-worn configuration on the head of a user”, and rotatable in “both a left and right rotation in a head-worn configuration on the head of a user .

... to a hand-held configuration.” Claim 1, for example. The O’Malley reference cannot perform and does not teach, suggest or motivate to rotate in both a left and right rotation in a head-worn configuration on the head of a user, much less to do so in a head-worn configuration on the head of a user to a hand-held configuration.

Furthermore, as the claim limitations are not even taught by the prior art, no reasonable chance of success exists to combine elements that are lacking in the prior art. Even to assume that, for example and only by way of argument sake, claim limitations such as “in a head-worn configuration on the head of a user”, and rotatable in “both a left and right rotation in a head-worn configuration on the head of a user ... to a hand-held configuration,” as in Claim 1 were in some manner taught, the limitations of the O’Malley et al. technology would offer no reasonable expectation of success.

Again, given that the headset of U.S. Patent No. 4,634,816 will only rotate in one direction when on the head of the user, the stirrups 14 hitting, contacting or interfering with the head of the user and the speaker and other portions of that traditional headset. It cannot rotate in both directions when in a head-worn configuration on the head of a user to a hand-held configuration. The technology of the ‘816 patent cannot rotate in one direction in a head-worn configuration on the head of a user without the stirrup interfering with use of the headset on the head of the user, such that the stirrup will either or in combination hit or contact the head or the user, be interposed between or obstruct the ear of the user relative to the ear piece, or will not rotate given interference between the stirrup and other portions of the earpiece and/or the microphone to a hand-held configuration. These functional and feature incompatibilities and lack of solutions to the problem in the ‘816 patent and other cited references make the present invention novel and nonobvious as claimed at least for these reasons.

The proposed modification would change the principal of operation

The proposed modification suggested by the Examiner, even if assumed that the missing claim elements were taught, suggested or motivated by the prior art, cannot change the principal of operation. MPEP 2143.01VI.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *Id.*, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” 270 F.2d at 813, 123 USPQ at 352.).

In the instance of the cited reference O’Malley et al., and other art of record, the suggested combination of prior art would require a substantial reconstruction of the technology and elements shown in the primary reference of O’Malley et al. as well as a change in the basic principle under which the primary O’Malley et al. reference was designed to operate. Again, the traditional O’Malley et al. headset disclosed does not operate to provide left and right rotation in a head-worn configuration, and such left and right rotation in the head-worn configuration on the head of a user to a hand-held configuration. Given that the headset of U.S. Patent No. 4,634,816 will only rotate in one direction when on the head of the user, the stirrups 14 hitting, contacting or interfering with the head of the user and the speaker and other portions of that traditional headset. It cannot rotate in both directions when in a head-worn configuration on the head of a user to a hand-held configuration.

The technology of the ‘816 patent cannot rotate in one direction in a head-worn configuration on the head of a user without the stirrup interfering with use of the headset on the head of the user, such that the stirrup will either or in combination hit or contact the head or the user, be interposed between or obstruct the ear of the user relative to the ear piece, or will not rotate given interference between the stirrup and other portions of the earpiece and/or the microphone to a hand-held configuration. These functional and feature incompatibilities would require a substantial reconstruction in order to feature

and operate the claimed limitations and would change the basic principal under which O'Malley et al. was designed to operate.

Accordingly, the suggestion or motivation to combine or modify the references does not exist. MPEP 2143.01.

Dependent Claims

Furthermore, and as it each of the dependent claims of the present application, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending there from is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

CONCLUSION

The Examiner has alleged that the O'Malley reference is the primary prior art "since it clearly teaches the earpiece of a telephone headset is mounted on pivot members to pivot about an axis generally in the plane of the headband being capable of pivoting for about 120 degrees to enable pivoting of the earpiece such that it can be held against an ear without the headband being on the users head" and that "O'Malley teaches a headset that may be configured for the head worn or hand held configurations." Outstanding Office Action, p 4 (page 2 of detailed action). However, O'Malley, and the other references of record, does not teach the recited elements and function of when "in a head-worn configuration on the head of a user", or rotatable in "both a left and right rotation in a head-worn configuration on the head of a user . . . to a hand-held configuration." Claim 1; see claims 35, 37, and 63. The O'Malley technology utilizes features such as stirrups that prevent the headset from rotating in both directions when on the head of a user to a hand held configuration, the stirrups contacting the head of the user or portions of the headset that prevent rotation in both a left and right rotation in a head-worn configuration on the head of a user to a hand-held configuration. The other art of record does not teaching the missing limitations, does provide any suggestion or motivation, and is not relied upon by the examiner for these claimed limitations. Accordingly, the art of record does not teach nor suggest the

invention as presently claimed.

In light of the above remarks, the Examiner's early reconsideration is earnestly requested.

If any outstanding issues remain with respect to this present request for reconsideration, the Examiner is respectfully requested to contact the undersigned attorney of record at his earliest convenience to initiate the resolution of any remaining concerns.

Dated this 23rd day of September, 2008.

Respectfully submitted,
Law Office of Chad C. Soliz, LLC

/Chad C. Soliz/

Chad C. Soliz
Registration No. 47,101
407 N. Lincoln Ave., Ste. 105
Loveland, CO 80537
(970) 461-9375